

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Fernando Incertis Carro et al.

Examiner: Kamal, Shahid

Application No.: 10/530,535

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For: **SYSTEM AND METHOD FOR SELECTING, ORDERING AND ACCESSING  
COPYRIGHTED INFORMATION FROM PHYSICAL DOCUMENTS**

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**BRIEF OF APPELLANT**

This Appeal Brief, pursuant to the Notice of Appeal filed December 1, 2008, is an appeal from the rejection of the Examiner in the Final Office Action dated September 3, 2008.

**REAL PARTY IN INTEREST**

International Business Machines, Inc. is the real party in interest.

**RELATED APPEALS AND INTERFERENCES**

None.

**STATUS OF CLAIMS**

Claims 1, 9 and 11 are rejected. Claims 2-8, 10 and 12-24 are cancelled. This Brief is in support of an appeal from the rejection of claims 1, 9 and 11.

**STATUS OF AMENDMENTS**

Appellant's filed a response to the Final Office Action dated September 3, 2008. This response does not contain any amendment to the claims and specification.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

### **A. CLAIM 1 - INDEPENDENT**

The present invention provides a method, comprising computer-implemented steps, for processing edited objects associated with a copyrighted physical document (600, FIG. 6) (see specification, page 15, lines 17-21). The method is for use in a user workstation (603, FIG. 6) by a user (see specification, page 11, lines 24-26).

A position of a point pressed on a touch foil of an opto-touch foil (601, FIG. 6) aligned over or under a portion of the copyrighted physical document is determined. Said portion comprises a plurality of items (604, FIG. 6). Said point was pressed to select an item of the plurality of items during illumination of the plurality of items by a light emitting foil of the opto-touch foil. Said pressed point was pressed to select an item of the plurality of items during illumination of the plurality of items by a light emitting foil of the opto-touch foil, said pressed point aligned proximate to the selected item (605, FIG. 6). See steps 1604-1606 of FIG. 16; specification, page 16, lines 4-13.

The selected item is identified by correlating the determined position of the pressed point with a position of the selected item in a list of item positions recorded in an item position column of an edited objects table (300, FIG. 3). Said list of item positions is associated with the plurality of items on the page of the physical document. See steps 1602-1603 and 1607-1608 of FIG. 16; specification, page 15, line 24 - page 16, line 3; page 16, lines 14-22.

The edited objects table is stored in the user workstation. See specification, page 17, lines 30-32.

The edited objects table comprises a header section (301, FIG. 3) and a body section (310, FIG. 3). The header section comprises a Uniform Resource Locator (URL) (302, FIG. 3) of the edited objects server, a publication number (303, FIG. 3) of the physical document, a title (304, FIG. 3) of the physical document, an author (305, FIG. 3) of the physical document, a date of publication (306, FIG. 3) of the physical document, and an International Standard Book Number (ISBN) (307, FIG. 3) of the physical document. The body section comprises a plurality of rows and three columns, wherein each row of the plurality of rows is specific to a copyrighted edited object. The three columns consist of the item position column comprising a position (311, FIG. 3) of the edited object on the page, an item name column comprising a name of the edited object, and an edited object path column comprising either a file path (313, FIG. 3) to the edited object on the user workstation which denotes that the user has a license to use and/or copy the edited object or informing text indicating that the edited object does not exist on the user workstation which denotes that the user does not have the license to use and/or copy the edited object. The edited object path column for at least one row of the plurality of rows comprises the file path to the edited object specific to each row of the at least one row. The edited object path column for each row of at least one other row of the plurality of rows comprises the informing text. An edited object in the edited objects table is identified from an edited object name (312, FIG. 3) denoted in the item name column in a determined row of the edited objects table in which there is an association of the edited object with the selected item resulting from said correlating. See FIG. 3; specification, page 18, lines 6-27.

It is ascertained, from the informing text in the edited object path column of the determined row, that the user does not have a license to use and/or copy the first edited object. (see Path column in FIG. 3 showing the paths in the edited objects table; specification, page 20, lines 14-23 stating that if the user has a license then the path must be in the edited objects table).

After it is ascertained that the user does not have a license to use and/or copy the first edited object, a request for information concerning the first edited object is sent from the user workstation to the edited objects server (see step 1610, FIG. 16; specification, page 16, lines 28-31). The request comprises an identification of the physical document, an identification of the page, and an identification of the selected item (see specification, page 17, line 1-5).

The user workstation receives the requested information from the edited objects server (see step 1611, FIG. 16; specification, page 17, lines 6-8). The received requested information comprises license terms and conditions as well as pricing and ordering information pertaining to the first edited object (see specification, page 16, line 30 - page 17, line 1).

After the requested information is received, the received requested information is displayed on the user workstation. See step 1611, FIG. 16; specification, page 17, line 8.

After said displaying or playing the received requested information is displayed or played (see specification, page 8, lines 5-7), an order is sent from the user workstation to the edited objects server for the license (see step 1612, FIG. 16; specification, page 17, lines 9-11). The order comprises the identification of the physical document, the page, the selected item, and payment data relating to the selected item and required by a publisher of the physical document (see specification, page 17, lines 12-16).

After the order is sent, the edited object with the license is received by the user workstation from the edited objects server. The received first edited object is stored in the user workstation. See step 1613, FIG. 16; specification, page 17, lines 17-19.

The edited object path column is updated in the edited objects table in the user workstation with a file path for accessing the stored received first edited object. See step 1614, FIG. 16; specification, page 17, lines 20-23.

#### B. CLAIM 9 - INDEPENDENT

The present invention provides a method, comprising computer-implemented steps, for processing edited objects associated with a copyrighted physical document (600, FIG. 6) (see specification, page 15, lines 17-21). The method is for use in a user workstation (603, FIG. 6) by a user (see specification, page 11, lines 24-26).

A position of a point pressed on a touch foil of an opto-touch foil (601, FIG. 6) aligned over or under a portion of the copyrighted physical document is determined. Said portion comprises a plurality of items (604, FIG. 6). Said point was pressed to select an item of the plurality of items during illumination of the plurality of items by a light emitting foil of the opto-touch foil. Said pressed point is aligned proximate to the selected item (605, FIG. 6). See steps 1605-1606 of FIG. 16; specification, page 16, lines 7-13.

The selected item is identified by correlating the determined position of the pressed point with a position of the selected item in a list of item positions recorded in an edited objects table (300, FIG. 3). Said list of item positions is associated with the plurality of items on the portion of the physical document. An edited object in the edited objects table is identified from association of the edited object with the selected item in the edited objects table. See steps 1602-10/530,535

1603 and 1607-1608 of FIG. 16; specification, page 15, line 24 - page 16, line 3; page 16, lines 14-22.

The edited objects table is stored in the user workstation. See specification, page 17, lines 30-32.

It is ascertained whether the user has a license to use and/or copy the edited object. If it is ascertained that the user has the license then the edited object is accessed from the user workstation and the edited object is displayed (see specification, page 12, lines 16-17; step 1609, FIG. 16; specification, page 16, lines 23-27). If it is ascertained that the user does not have the license then the license and the edited object are obtained from an edited objects server (see specification, page 12, lines 18-20; step 1610, FIG. 16; specification, page 16, lines 28-31). It is ascertained that the user does not have the license (see specification, page 20, lines 24-26).

Said obtaining the license and the edited object from the edited objects server comprises: sending an order for the license to an edited objects server (see step 1612, FIG. 16; specification, page 17, lines 9-11; page 6, line 2); receiving the edited object with the license from the edited objects server (see step 1613, FIG. 16; specification, page 17, lines 17-18; page 6, line 3); storing the edited object in the user workstation (see; specification, page 17, line 19; page 6, line 4); updating the edited objects table with a file path for accessing the stored edited object (see step 1614, FIG. 16; specification, page 17, lines 20-23; page 6, line 5); indicating in the edited objects table that the user has the license (see specification, page 6, lines 6-7).

Said sending the order for the license to the edited objects server comprises sending to the edited objects server a request for information concerning the edited object. See step 1610, FIG. 16; specification, page 16, lines 30-31.

The requested information is received from the edited objects server. See step 1611, FIG. 16; specification, page 17, lines 6-7.

The received information concerning the edited object is displayed or played. See step 1611, FIG. 16; specification, page 17, line 8; page 8, lines 5-7.

The physical document is a printed document comprising at least one page. The portion of the physical document is a page of the at least one page. See specification, page 11, lines 19-20.

The requested information comprises: license terms and conditions; pricing and ordering information; and an identification of the physical document, the page, and the selected item. See specification, page 16, line 30 - page 17, line 5.

### C. CLAIM 11 - INDEPENDENT

The present invention provides a method, comprising computer-implemented steps, for processing edited objects associated with a copyrighted physical document (600, FIG. 6) (see specification, page 15, lines 17-21). The method is for use in a user workstation (603, FIG. 6) by a user (see specification, page 11, lines 24-26).

A position of a point pressed on a touch foil of an opto-touch foil (601, FIG. 6) aligned over or under a portion of the copyrighted physical document is determined. Said portion comprises a plurality of items (604, FIG. 6). Said point was pressed to select an item of the plurality of items during illumination of the plurality of items by a light emitting foil of the opto-touch foil. Said pressed point is aligned proximate to the selected item (605, FIG. 6). See steps 1605-1606 of FIG. 16; specification, page 16, lines 7-13.

The selected item is identified by correlating the determined position of the pressed point with a position of the selected item in a list of item positions recorded in an edited objects table (300, FIG. 3). Said list of item positions is associated with the plurality of items on the portion of the physical document. An edited object in the edited objects table is identified from association of the edited object with the selected item in the edited objects table. See steps 1602-1603 and 1607-1608 of FIG. 16; specification, page 15, line 24 - page 16, line 3; page 16, lines 14-22.

The edited objects table is stored in the user workstation. See specification, page 17, lines 30-32.

It is ascertained whether the user has a license to use and/or copy the edited object. If it is ascertained that the user has the license then the edited object is accessed from the user workstation and the edited object is displayed (see specification, page 12, lines 16-17; step 1609, FIG. 16; specification, page 16, lines 23-27). If it is ascertained that the user does not have the license then the license and the edited object are obtained from an edited objects server (see specification, page 12, lines 18-20; step 1610, FIG. 16; specification, page 16, lines 28-31). It is ascertained that the user does not have the license (see specification, page 20, lines 24-26).

Said obtaining the license and the edited object from the edited objects server comprises: sending an order for the license to an edited objects server (see step 1612, FIG. 16; specification, page 17, lines 9-11; page 6, line 2); receiving the edited object with the license from the edited objects server (see step 1613, FIG. 16; specification, page 17, lines 17-18; page 6, line 3); storing the edited object in the user workstation (see; specification, page 17, line 19; page 6, line 4); updating the edited objects table with a file path for accessing the stored edited object (see step



1614, FIG. 16; specification, page 17, lines 20-23; page 6, line 5); indicating in the edited objects table that the user has the license (see specification, page 6, lines 6-7).

The edited objects table comprises rows and columns, wherein each row is associated with a unique edited object, and wherein the columns comprise a column for item position, a column for item name (312, FIG. 3), and a column for the file path (313, FIG. 3) for accessing the edited object. See FIG. 3; specification, page 18, lines 22-27.

#### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

1. Claims 1, 9 and 11 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Patterson (US Patent No.: 6,389,541 B1) in view of Bell et al. (US Pub. No.: 2003/0130952).

## ARGUMENT

### GROUND OF REJECTION 1

Claims 1, 9 and 11 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Patterson (US Patent No.: 6,389,541 B1) in view of Bell et al. (US Pub. No.: 2003/0130952).

#### Claim 1

Appellants respectfully contend that claim 1 is not unpatentable over Patterson in view of Bell, because Patterson in view of Bell does not teach or suggest each and every feature of claim 1.

As a first example of why claim 1 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “identifying the selected item by correlating the determined position of the pressed point with a position of the selected item in a list of item positions recorded in an item position column of an edited objects table that is stored in the user workstation, said list of item positions being associated with the plurality of items on the page of the physical document”.

The Examiner argues that Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 discloses the preceding feature of claim 1.

In response, Appellants respectfully contend that Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 does not mention anything about “a position of the selected item in a list of item positions recorded in an item position column of an edited objects table that is stored in the user workstation”, and does not mention anything about “said list of item positions being

associated with the plurality of items on the page of the physical document”, and does not mention anything about said “correlating ...”. Moreover, Patterson does mention anything about a physical document, but instead discloses an electronic document that is a data file comprising digital content such as text, video, music, multimedia documents with text, (e.g., see Patterson, abstract, line 1 and col. 7, lines 26-27).

In further response, Appellants respectfully contend that the only table-like entity disclosed in Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 is a data file comprising digital content such as text, video, music, multimedia documents with text, (e.g., see Patterson, abstract, line 1 and col. 7, lines 26-27). Paterson does not anywhere disclose that the data file has “a position of the selected item in a list of item positions recorded in an item position column”. Patterson does not even disclose that the data file comprise a column of information of any kind.

Therefore, claim 1 is not unpatentable over Patterson in view of Bell.

As a second example of why claim 1 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “wherein the edited objects table comprises a header section ..., wherein the header section comprises a Uniform Resource Locator (URL) of the edited objects server, a publication number of the physical document, a title of the physical document, an author of the physical document, a date of publication of the physical document, and an International Standard Book Number (ISBN) of the physical document”.

The Examiner argues that Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 discloses the preceding feature of claim 1.

In response, Appellants respectfully contend that Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 does not disclose that a header section of the edited objects table comprises a URL of the edited objects server, a publication number, a title, an author, a date of publication, and an ISBN of the physical document .

Therefore, claim 1 is not unpatentable over Patterson in view of Bell.

As a third example of why claim 1 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “wherein the edited objects table comprises ... a body section, ... wherein the body section comprises a plurality of rows and three columns”.

The Examiner argues that Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 discloses the preceding feature of claim 1.

In response, Appellants respectfully contend that Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 does not disclose that a body section comprises a plurality of rows and three columns.

Therefore, claim 1 is not unpatentable over Patterson in view of Bell.

As a fourth example of why claim 1 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “wherein each row of the plurality of rows is specific to a copyrighted edited object”.

The Examiner argues that Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 discloses the preceding feature of claim 1.

In response, Appellants respectfully contend that Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 does not disclose that a row in the edited objects table is specific to a copyrighted edited object. Patterson in view of Bell does not even disclose the existence of a row of any kind for any purpose in the edited objects table.

Therefore, claim 1 is not unpatentable over Patterson in view of Bell.

As a fifth example of why claim 1 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: "wherein the three columns consist of the item position column comprising a position of the edited object on the page, an item name column comprising a name of the edited object, and an edited object path column comprising either a file path to the edited object on the user workstation which denotes that the user has a license to use and/or copy the edited object or informing text indicating that the edited object does not exist on the user workstation which denotes that the user does not have the license to use and/or copy the edited object".

The Examiner argues that Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 discloses the preceding feature of claim 1.

In response, Appellants respectfully contend that Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 does not disclose the existence of preceding three recited columns in the edited objects table.

Therefore, claim 1 is not unpatentable over Patterson in view of Bell.

As a sixth example of why claim 1 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: "wherein the edited object path

column for at least one row of the plurality of rows comprises the file path to the edited object specific to each row of the at least one row, and wherein the edited object path column for each row of at least one other row of the plurality of rows comprises the informing text”.

The Examiner argues that Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 discloses the preceding feature of claim 1.

In response, Appellants respectfully contend that Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 does not disclose that the edited object path column comprises both the file path to the edited object (in at least one row) the informing text (in at least one other row).

Therefore, claim 1 is not unpatentable over Patterson in view of Bell.

As a seventh example of why claim 1 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “identifying an edited object in the edited objects table from an edited object name denoted in the item name column in a determined row of the edited objects table in which there is an association of the edited object with the selected item resulting from said correlating”.

The Examiner argues that Patterson, FIG. 4 and associated text, col. 4, lines 13-28 discloses the preceding feature of claim 1.

In response, Appellants respectfully contend that Patterson, FIG. 4 and associated text, col. 4, lines 13-28 does not disclose that an edited object name denoted in the item name column in a determined row of the edited objects table identifies the edited object.

Therefore, claim 1 is not unpatentable over Patterson in view of Bell.

As a eighth example of why claim 1 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: "ascertaining, from the informing text in the edited object path column of the determined row, that the user does not have a license to use and/or copy the first edited object".

The Examiner argues that Patterson, col. 4, lines 13-28 discloses the preceding feature of claim 1.

In response, Appellants respectfully contend that Patterson, col. 4, lines 13-28 does not disclose ascertaining, from the informing text in the edited object path column of the determined row, that the user does not have a license to use and/or copy the first edited object.

Therefore, claim 1 is not unpatentable over Patterson in view of Bell.

As a ninth example of why claim 1 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: "after said ascertaining, sending, from the user workstation to the edited objects server, a request for information concerning the first edited object, wherein the request comprises an identification of the physical document, an identification of the page, and an identification of the selected item".

The Examiner argues that Patterson, col. 10, lines 49-67 discloses the preceding feature of claim 1.

In response, Appellants respectfully contend that Patterson, col. 10, lines 49-67 does not disclose sending the recited request for information (comprising an identification of the physical document, an identification of the page, and an identification of the selected item) from the user workstation to the edited objects server.

Therefore, claim 1 is not unpatentable over Patterson in view of Bell.

As a tenth example of why claim 1 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “receiving, by the user workstation from the edited objects server, the requested information, wherein the received requested information comprises license terms and conditions as well as pricing and ordering information pertaining to the first edited object”.

The Examiner argues that Patterson, col. 4, lines 13-28 discloses the preceding feature of claim 1.

In response, Appellants respectfully contend that Patterson, col. 4, lines 13-28 does not disclose receiving any requested information concerning the edited object, and that Patterson, col. 4, lines 13-28 does not most certainly does not disclose requesting information comprising “license terms and conditions as well as pricing and ordering information pertaining to the first edited object”.

Therefore, claim 1 is not unpatentable over Patterson in view of Bell.

As a eleventh example of why claim 1 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “after said receiving the requested information, displaying the received requested information on the user workstation”.

The Examiner argues that Patterson, col. 4, lines 13-28 discloses the preceding feature of claim 1.

In response, Appellants respectfully contend that Patterson, col. 4, lines 13-28 does not disclose “displaying the received requested information” and most certainly not disclose “displaying the received requested information on the user workstation”.

Therefore, claim 1 is not unpatentable over Patterson in view of Bell.



As a twelfth example of why claim 1 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “after said displaying or playing the received requested information, sending an order from the user workstation to the edited objects server for the license, wherein the order comprises the identification of the physical document, the page, the selected item, and payment data relating to the selected item and required by a publisher of the physical document”.

The Examiner argues that Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 discloses the preceding feature of claim 1.

In response, Appellants respectfully contend that Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 does not disclose that the order may include the page and both the selected item and an identification of the physical document.

Therefore, claim 1 is not unpatentable over Patterson in view of Bell.

As a thirteenth example of why claim 1 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “after said sending the order, receiving, by the user workstation from the edited objects server, the edited object with the license”.

The Examiner argues that Pattern, col. 4, lines 13-28 discloses the preceding feature of claim 1.

In response, Appellants respectfully contend that Patterson, col. 4, lines 13-28 does not disclose that the user workstation receives the edited object **with the license** from the edited objects server.

Therefore, claim 1 is not unpatentable over Patterson in view of Bell.

As a fourteenth example of why claim 1 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “updating the edited object path column in the edited objects table in the user workstation with a file path for accessing the stored received first edited object”.

The Examiner argues that Patterson, col. 4, lines 1-12 and col. 7, lines 17-47 discloses the preceding feature of claim 1.

In response, Appellants contend that Patterson, col. 4, lines 1-12 and col. 7, lines 17-47 discloses that digital content is downloaded to the client computer, but does not disclose that the edited object path column in the edited objects table is updated in the user workstation with a file path for accessing the stored received first edited object.

Therefore, claim 1 is not unpatentable over Patterson in view of Bell.

Based on the preceding arguments, Appellants respectfully maintain that claim 1 is not unpatentable over Patterson in view of Bell, and that claim 1 is in condition for allowance.

#### Claim 9

Appellants respectfully contend that claim 9 is not unpatentable over Patterson in view of Bell, because Patterson in view of Bell does not teach or suggest each and every feature of claim 9.

As a first example of why claim 9 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “identifying the selected item by correlating the determined position of the pressed point with a position of the selected item in a

list of item positions recorded in an item position column of an edited objects table that is stored in the user workstation, said list of item positions being associated with the plurality of items on the page of the physical document”.

The Examiner argues that Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 disclose the preceding feature of claim 9.

In response, Appellants respectfully contend that Patterson, abstract, col. 4, lines 1-12, col. 7, lines 17-47 does not mention anything about “a position of the selected item in a list of item positions recorded in an item position column of an edited objects table that is stored in the user workstation”, and does not mention anything about “said list of item positions being associated with the plurality of items on the page of the physical document”, and does not mention anything about said “correlating ...”. Moreover, Patterson does mention anything about a physical document, but instead discloses an electronic document that is a data file comprising digital content such as text, video, music, multimedia documents with text, (e.g., see Patterson, abstract, line 1 and col. 7, lines 26-27).

Therefore, claim 9 is not unpatentable over Patterson in view of Bell.

As a second example of why claim 9 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “identifying an edited object in the edited objects table from association of the edited object with the selected item in the edited objects”.

The Examiner argues that Patterson, FIG. 4 and associated text, col. 4, lines 13-28 discloses the preceding feature of claim 1.

In response, Appellants respectfully contend that Patterson, FIG. 4 and associated text, col. 4, lines 13-28 does not mention anything about an “association of the edited object with the selected item in the edited objects” being used for “identifying an edited object in the edited objects table”.

Therefore, claim 9 is not unpatentable over Patterson in view of Bell.

As a third example of why claim 9 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “ascertaining whether the user has a license to use and/or copy the edited object”.

The Examiner argues that Patterson, col. 10, lines 49-67 discloses the preceding feature of claim 9.

In response, Appellants respectfully contend that Patterson, col. 10, lines 49-67 does not disclose ascertaining whether the user has a license to use and/or copy the edited object.

Therefore, claim 9 is not unpatentable over Patterson in view of Bell.

As a fourth example of why claim 9 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “if said ascertaining ascertains that the user has the license then accessing the edited object from the user workstation and displaying the edited object, and if said ascertaining ascertains that the user does not have the license then obtaining the license and the edited object from an edited objects server”.

The Examiner does not even allege that Patterson discloses the preceding feature of claim 9.

Therefore, claim 9 is not unpatentable over Patterson in view of Bell.

As a fifth example of why claim 9 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “said obtaining the license and the edited object from the edited objects server comprises: sending an order for the license to an edited objects server”.

The Examiner argues that Patterson, col. 4, lines 13-28 discloses the preceding feature of claim 9.

In response, Appellants respectfully contend that Patterson, col. 4, lines 13-28 does not disclose that obtaining the license and the edited object from the edited objects server comprises sending an order for the license to an edited objects server.

Therefore, claim 9 is not unpatentable over Patterson in view of Bell.

As a sixth example of why claim 9 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “said obtaining the license and the edited object from the edited objects server comprises: ... receiving the edited object with the license from the edited objects server”.

The Examiner argues that Pattern, col. 4, lines 13-28 discloses receiving the edited object with the license from the edited objects server.

In response, Appellants respectfully contend that Patterson, col. 4, lines 13-28 does not disclose that obtaining the license and the edited object from the edited objects server comprises receiving the edited object **with the license** from the edited objects server.

Therefore, claim 9 is not unpatentable over Patterson in view of Bell.

As a seventh example of why claim 9 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “updating the edited objects table with a file path for accessing the stored edited object”.

The Examiner does not even allege that discloses that Patterson discloses the preceding feature of claim 9.

Therefore, claim 9 is not unpatentable over Patterson in view of Bell.

As a eighth example of why claim 9 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “indicating in the edited objects table that the user has the license”.

The Examiner does not even allege that discloses that Patterson discloses the preceding feature of claim 9.

Therefore, claim 9 is not unpatentable over Patterson in view of Bell.

As a ninth example of why claim 9 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “wherein said sending the order for the license to the edited objects server comprises sending to the edited objects server a request for information concerning the edited object”.

The Examiner does not even allege that discloses that Patterson discloses the preceding feature of claim 9.

Therefore, claim 9 is not unpatentable over Patterson in view of Bell.

As a tenth example of why claim 9 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “receiving the requested information from the edited objects server”.

The Examiner argues that Patterson, col. 4, lines 13-28 discloses the preceding feature of claim 9.

In response, Appellants respectfully contend that Patterson, col. 4, lines 13-28 does not disclose “receiving the requested information from the edited objects server”.

Therefore, claim 9 is not unpatentable over Patterson in view of Bell.

As an eleventh example of why claim 9 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “wherein the requested information comprises: license terms and conditions”.

The Examiner argues that Patterson, col. 4, lines 13-29 discloses the preceding feature of claim 9.

In response, Appellants respectfully contend that Patterson, col. 4, lines 13-29 does not disclose that the request for information concerning the edited object comprises license terms and conditions.

Therefore, claim 9 is not unpatentable over Patterson in view of Bell.

As an twelfth example of why claim 9 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “wherein the requested information comprises: ... pricing and ordering information”.

The Examiner argues that Patterson, FIG. 8 discloses the preceding feature of claim 9.

In response, Appellants respectfully contend that Patterson, FIG. 8 does not disclose that the request for information concerning the edited object comprises pricing and ordering information.

Therefore, claim 9 is not unpatentable over Patterson in view of Bell.

As an thirteenth example of why claim 9 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “wherein the requested information comprises: ... an identification of the physical document, the page, and the selected item”.

The Examiner argues that Patterson, abstract, FIG. 4 and associated text, col. 4, lines 1-12, col. 7, lines 17-47 discloses the preceding feature of claim 9.

In response, Appellants respectfully contend that Patterson, abstract, FIG. 4 and associated text, col. 4, lines 1-12, col. 7, lines 17-47 does not disclose that the request for information concerning the edited object comprises an identification of the physical document, the page, and the selected item.

Therefore, claim 9 is not unpatentable over Patterson in view of Bell.

Based on the preceding arguments, Appellants respectfully maintain that claim 9 is not unpatentable over Patterson in view of Bell, and that claim 9 is in condition for allowance.

#### Claim 11



Appellants respectfully contend that claim 11 is not unpatentable over Patterson in view of Bell, because Patterson in view of Bell does not teach or suggest each and every feature of claim 11.

As a first example of why claim 11 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “identifying the selected item by correlating the determined position of the pressed point with a position of the selected item in a list of item positions recorded in an item position column of an edited objects table that is stored in the user workstation, said list of item positions being associated with the plurality of items on the page of the physical document”.

The Examiner argues that Patterson, abstract, FIG. 4 and associated text, col. 4, lines 1-12, col. 7, lines 17-47 disclose the preceding feature of claim 11.

In response, Appellants respectfully contend that Patterson, abstract, FIG. 4 and associated text, col. 4, lines 1-12, col. 7, lines 17-47 does not mention anything about “a position of the selected item in a list of item positions recorded in an item position column of an edited objects table that is stored in the user workstation”, and does not mention anything about “said list of item positions being associated with the plurality of items on the page of the physical document”, and does not mention anything about said “correlating ...”. Moreover, Patterson does mention anything about a physical document, but instead discloses an electronic document that is a data file comprising digital content such as text, video, music, multimedia documents with text, (e.g., see Patterson, abstract, line 1 and col. 7, lines 26-27).

Therefore, claim 11 is not unpatentable over Patterson in view of Bell.

As a second example of why claim 11 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “identifying an edited object in the edited objects table from association of the edited object with the selected item in the edited objects”.

The Examiner argues that Patterson, FIG. 4 and associated text, col. 4, lines 13-28 disclose the preceding feature of claim 11.

In response, Appellants respectfully contend that Patterson, FIG. 4 and associated text, col. 4, lines 13-28 does not mention anything about an “association of the edited object with the selected item in the edited objects” being used for “identifying an edited object in the edited objects table”.

Therefore, claim 11 is not unpatentable over Patterson in view of Bell.

As a third example of why claim 11 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “ascertaining whether the user has a license to use and/or copy the edited object”.

The Examiner argues that Patterson, col. 10, lines 49-67 discloses the preceding feature of claim 11.

In response, Appellants respectfully contend that Patterson, col. 10, lines 49-67 does not disclose performing the test of “ascertaining whether the user has a license to use and/or copy the edited object”.

Therefore, claim 11 is not unpatentable over Patterson in view of Bell.

As a fourth example of why claim 11 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: "if said ascertaining ascertains that the user does not have the license then obtaining the license and the edited object from an edited objects server, wherein said ascertaining ascertains that the user does not have the license".

The Examiner does not even allege that discloses that Patterson discloses the preceding feature of claim 11.

Therefore, claim 11 is not unpatentable over Patterson in view of Bell.

As a fifth example of why claim 11 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: "said obtaining the license and the edited object from the edited objects server comprises: sending an order for the license to an edited objects server".

The Examiner argues that Patterson, col. 4, lines 13-28 discloses the preceding feature of claim 11.

In response, Appellants respectfully contend that Patterson, col. 4, lines 13-28 does not disclose that obtaining the license and the edited object from the edited objects server comprises sending an order for the license to an edited objects server.

Therefore, claim 11 is not unpatentable over Patterson in view of Bell.

As a sixth example of why claim 11 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: "said obtaining the license and the edited object from the edited objects server comprises: ... receiving the edited object with the license from the edited objects server".

The Examiner argues that Pattern, col. 4, lines 13-28 discloses the preceding feature of claim 11..

In response, Appellants respectfully contend that Patterson, col. 4, lines 13-28 does not disclose that obtaining the license and the edited object from the edited objects server comprises receiving the edited object **with the license** from the edited objects server.

Therefore, claim 11 is not unpatentable over Patterson in view of Bell.

As a seventh example of why claim 11 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “said obtaining the license and the edited object from the edited objects server comprises: ... updating the edited objects table with a file path for accessing the stored edited object”.

The Examiner argues that Patterson, col. 4, lines 1-12 and col. 7, lines 17-47 the preceding feature of claim 11.

In response, Appellants contend that Patterson, col. 4, lines 1-12 and col. 7, lines 17-47 discloses that digital content is downloaded to the client computer, but does not disclose that obtaining the license and the edited object from the edited objects server comprises updating the edited objects table with a file path for accessing the stored edited object.

Therefore, claim 11 is not unpatentable over Patterson in view of Bell.

As a eighth example of why claim 11 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “indicating in the edited objects table that the user has the license”.

The Examiner does not even allege that Patterson discloses the preceding feature of claim 11.

Therefore, claim 11 is not unpatentable over Patterson in view of Bell.

As a ninth example of why claim 11 is not unpatentable over Patterson in view of Bell, Patterson in view of Bell does not teach or suggest the feature: “wherein the edited objects table comprises rows and columns, wherein each row is associated with a unique edited object, and wherein the columns comprise a column for item position, a column for item name, and a column for the file path for accessing the edited object”.

The Examiner does not even allege that Patterson discloses the preceding feature of claim 11.

Therefore, claim 11 is not unpatentable over Patterson in view of Bell.

Based on the preceding arguments, Appellants respectfully maintain that claim 11 is not unpatentable over Patterson in view of Bell, and that claim 11 is in condition for allowance.

### SUMMARY

In summary, Appellants respectfully requests reversal of the September 3, 2008 Office Action rejection of claims 1, 9 and 11.

Date: 12/05/2008

Jack P. Friedman  
Jack P. Friedman  
Registration No.: 44,688

Schmeiser, Olsen & Watts  
22 Century Hill Drive – Suite 302  
Latham, New York 12110  
(518) 220-1850 Telephone  
(518) 229-1857 Facsimile  
E-mail: [jfriedman@iplawusa.com](mailto:jfriedman@iplawusa.com)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Fernando Incertis Carro et al.

Examiner: Kamal, Shahid

Application No.: 10/530,535

Group Art Unit: 3621 / Conf. # 4718

Filing Date: 04/06/2005

Docket No.: FR920020063US1

For: **SYSTEM AND METHOD FOR SELECTING, ORDERING AND ACCESSING  
COPYRIGHTED INFORMATION FROM PHYSICAL DOCUMENTS**

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

APPENDIX A - CLAIMS ON APPEAL

1. A method for processing edited objects associated with a copyrighted physical document, the method for use in a user workstation by a user, said method comprising the computer-implemented steps of:

determining a position of a point pressed on a touch foil of an opto-touch foil aligned over or under a page of the copyrighted physical document, said page comprising a plurality of items, said point having been pressed to select an item of the plurality of items during illumination of the plurality of items by a light emitting foil of the opto-touch foil, said pressed point aligned proximate to the selected item;

identifying the selected item by correlating the determined position of the pressed point with a position of the selected item in a list of item positions recorded in an item position column of an edited objects table that is stored in the user workstation, said list of item positions being associated with the plurality of items on the page of the physical document, wherein the edited

objects table comprises a header section and a body section, wherein the header section comprises a Uniform Resource Locator (URL) of the edited objects server, a publication number of the physical document, a title of the physical document, an author of the physical document, a date of publication of the physical document, and an International Standard Book Number (ISBN) of the physical document, wherein the body section comprises a plurality of rows and three columns, wherein each row of the plurality of rows is specific to a copyrighted edited object, wherein the three columns consist of the item position column comprising a position of the edited object on the page, an item name column comprising a name of the edited object, and an edited object path column comprising either a file path to the edited object on the user workstation which denotes that the user has a license to use and/or copy the edited object or informing text indicating that the edited object does not exist on the user workstation which denotes that the user does not have the license to use and/or copy the edited object, wherein the edited object path column for at least one row of the plurality of rows comprises the file path to the edited object specific to each row of the at least one row, and wherein the edited object path column for each row of at least one other row of the plurality of rows comprises the informing text;

identifying an edited object in the edited objects table from an edited object name denoted in the item name column in a determined row of the edited objects table in which there is an association of the edited object with the selected item resulting from said correlating;

ascertaining, from the informing text in the edited object path column of the determined row, that the user does not have a license to use and/or copy the first edited object;

after said ascertaining, sending, from the user workstation to the edited objects server, a request for information concerning the first edited object, wherein the request comprises an



identification of the physical document, an identification of the page, and an identification of the selected item;

receiving, by the user workstation from the edited objects server, the requested information, wherein the received requested information comprises license terms and conditions as well as pricing and ordering information pertaining to the first edited object;

after said receiving the requested information, displaying the received requested information on the user workstation;

after said displaying or playing the received requested information, sending an order from the user workstation to the edited objects server for the license, wherein the order comprises the identification of the physical document, the page, the selected item, and payment data relating to the selected item and required by a publisher of the physical document;

after said sending the order, receiving, by the user workstation from the edited objects server, the edited object with the license;

storing the received first edited object in the user workstation;

updating the edited object path column in the edited objects table in the user workstation with a file path for accessing the stored received first edited object.

9. A method for processing edited objects associated with a copyrighted physical document, the method for use in a user workstation by a user, said method comprising the computer-implemented steps of:

determining a position of a point pressed on a touch foil of an opto-touch foil aligned over or under a portion of the copyrighted physical document, said portion comprising a plurality of items, said point having been pressed to select an item of the plurality of items during

illumination of the plurality of items by a light emitting foil of the opto-touch foil, said pressed point aligned proximate to the selected item;

identifying the selected item by correlating the determined position of the pressed point with a position of the selected item in a list of item positions recorded in an edited objects table that is stored in the user workstation, said list of item positions being associated with the plurality of items on the portion of the physical document;

identifying an edited object in the edited objects table from association of the edited object with the selected item in the edited objects table;

ascertaining whether the user has a license to use and/or copy the edited object; and

if said ascertaining ascertains that the user has the license then accessing the edited object from the user workstation and displaying the edited object, and if said ascertaining ascertains that the user does not have the license then obtaining the license and the edited object from an edited objects server,

wherein said ascertaining ascertains that the user does not have the license, and wherein said obtaining the license and the edited object from the edited objects server comprises:

sending an order for the license to an edited objects server;

receiving the edited object with the license from the edited objects server;

storing the edited object in the user workstation;

updating the edited objects table with a file path for accessing the stored edited

object;

indicating in the edited objects table that the user has the license,

wherein said sending the order for the license to the edited objects server comprises sending to the edited objects server a request for information concerning the edited object, and wherein the method further comprises:

receiving the requested information from the edited objects server; and

displaying or playing the received information concerning the edited object,

wherein the physical document is a printed document comprising at least one page, and wherein the portion of the physical document is a page of the at least one page, and wherein the requested information comprises:

license terms and conditions;

pricing and ordering information; and

an identification of the physical document, the page, and the selected item.

11. A method for processing edited objects associated with a copyrighted physical document, the method for use in a user workstation by a user, said method comprising the computer-implemented steps of:

determining a position of a point pressed on a touch foil of an opto-touch foil aligned over or under a portion of the copyrighted physical document, said portion comprising a plurality of items, said point having been pressed to select an item of the plurality of items during illumination of the plurality of items by a light emitting foil of the opto-touch foil, said pressed point aligned proximate to the selected item;

identifying the selected item by correlating the determined position of the pressed point with a position of the selected item in a list of item positions recorded in an edited objects table

that is stored in the user workstation, said list of item positions being associated with the plurality of items on the portion of the physical document;

identifying an edited object in the edited objects table from association of the edited object with the selected item in the edited objects table;

ascertaining whether the user has a license to use and/or copy the edited object; and

if said ascertaining ascertains that the user has the license then accessing the edited object from the user workstation and displaying the edited object, and if said ascertaining ascertains that the user does not have the license then obtaining the license and the edited object from an edited objects server,

wherein said ascertaining ascertains that the user does not have the license, and wherein said obtaining the license and the edited object from the edited objects server comprises:

sending an order for the license to an edited objects server;

receiving the edited object with the license from the edited objects server;

storing the edited object in the user workstation;

updating the edited objects table with a file path for accessing the stored edited

object;

indicating in the edited objects table that the user has the license,

wherein the edited objects table comprises rows and columns, wherein each row is associated with a unique edited object, and wherein the columns comprise a column for item position, a column for item name, and a column for the file path for accessing the edited object.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Fernando Incertis Carro et al.

Examiner: Kamal, Shahid

Application No.: 10/530,535

Group Art Unit: 3621 / Conf. # 4718

Filing Date: 04/06/2005

Docket No.: FR920020063US1

For: **SYSTEM AND METHOD FOR SELECTING, ORDERING AND ACCESSING  
COPYRIGHTED INFORMATION FROM PHYSICAL DOCUMENTS**

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Alexandria, VA 22313-1450

**APPENDIX B - EVIDENCE**

There is no evidence entered by the Examiner and relied upon by Appellants in this appeal.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Fernando Incertis Carro et al.

Examiner: Kamal, Shahid

Application No.: 10/530,535

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Alexandria, VA 22313-1450

**APPENDIX C - RELATED PROCEEDINGS**

There are no proceedings identified in the "Related Appeals and Interferences" section.